



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,504	03/14/2001	Ovidiu Platica	9693-004-999	3612

20583 7590 11/01/2002

PENNIE AND EDMONDS
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 100362711

EXAMINER

WHISENANT, ETHAN C

ART UNIT	PAPER NUMBER
----------	--------------

1634

DATE MAILED: 11/01/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/808,504

Applicant(s)

PLATICA, OVIDIU

Examiner

Ethan Whisenant, Ph.D.

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 12-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The applicant's response to the election/restriction requirement filed 09 AUG 02 has been entered as paper no. 13. The applicant's election of Group I (Claims 1-11) with traverse in paper no. 13 is acknowledged. Claims 12-14 are withdrawn from further consideration as being directed toward a non-elected invention.

The traversal of the restriction requirement is based on the applicant's contention that it is not a serious burden on the examiner to search both Groups I and II. The applicant's argument has been fully and carefully considered but is not deemed to be persuasive. Inventions I and II above are drawn to two independent and patentably distinct methods which comprise different goals, different intermediate steps and different reagents thereby requiring divergent searches which searches are not coextensive. Clearly there will be some overlap in the two searches, however, the two searches will not be coextensive. For example, nowhere in Group I is it required that at least first, second and third replicas of plates comprising cDNA library clones be prepared as is required in Group II. The restriction requirement has now been reconsidered in light of the applicant's remarks is deemed proper it is, therefore, herein made **FINAL**.

SEQUENCE RULES

2. This application complies with the sequence rules and the sequences have been entered by the Scientific and Technical Information Center.

35 USC § 112- 2ND PARAGRAPH

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

CLAIM REJECTIONS under 35 USC § 112- 2ND PARAGRAPH

4. Claim(s) 1-9 is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because the phrase "the base change" on the last line (i.e. line 12) is nonsequitur.

35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that may form the basis for rejections set forth in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

CLAIM REJECTIONS UNDER 35 USC § 102

6. Claim(s) 1-7 and 9 is/are rejected under 35 U.S.C. 102(e) as being anticipated by of Cotton et al. [US Patent No. 5,958,692 (1999)].

Cotton et al. teach a method of detecting base changes in a nucleic acid of interest comprising all of the limitations recited in Claim 1-7 and 9.

Note that Cotton et al. also teach the use of S1 nuclease in mutation detection methods. See for example, the bottom of Column 1.

35 USC § 103

- 7.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

CLAIM REJECTIONS UNDER 35 USC § 103

- 8.** **Claim(s) 10** is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Cotton et al. [US Patent No. 5,958,692 (1999)]

Cotton et al. teach a kit for detecting base changes in a nucleic acid of interest comprising all of the steps recited in Claim 10, see for example Column 4, beginning at about line 63 except these authors do not explicitly teach including in the kit a means for detecting the ligated probe, however, Cotton et al do teach autoradiography to detect the ligated probe, and therefore, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to include in the kit disclosed by Cotton et al. any and all reagents (e.g. autoradiographic film) necessary to carry out the method described by Cotton et al. See, for example, the section entitled "Brief Description of the Drawings". In addition, note especially, Column 18 beginning at about line 52 – Column 20 wherein Cotton et al. describes other non-radiological methods and reagents for detecting their labeled probes.

CLAIM OBJECTIONS

- 9.** **Claim(s) 8** is /are objected to because it is dependent upon a rejected independent base claim.

CONCLUSION

- 10.** **Claim(s) 1-11** is/are rejected and/or objected to for the reason(s) set forth above.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant, Ph.D. whose telephone number is (703) 308-6567. The examiner can normally be reached Monday-Friday from 8:30AM -5:30PM EST or any time via voice mail. If repeated attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152.

The fax number for this Examiner is (703) 746-8465. Before faxing any papers please inform the examiner to avoid lost papers. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989). Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-0196.



**ETHAN C. WHISENANT
PRIMARY EXAMINER**